

Remarks

Following the above amendments, claims 1, 4-8, 16, and 19-23 are pending in this application. The pending claims, including the remaining independent claims 1, 16, and 22, have each been rejected under 35 U.S.C. § 103(a) as being obvious over allegedly admitted prior art in view of Goodman et al. (U.S. Patent No. 6,282,601) and Smith et al. (U.S. Patent No. 3,643,227).

A. Independent Claims 1, 16, and 22

Each of the independent claims has been rejected as being obvious. Applicants submit that a *prima facie* case of obviousness has not been established and that a rejection of the pending claims on obviousness grounds is improper.

A *prima facie* case of obviousness requires a showing that all of the claim limitations of the rejected claims are taught or suggested by the prior art. Manual of Patent Examining Procedure 2143 and 2143.03. The establishment of a *prima facie* case of obviousness requires that *all* the claim limitations be taught or suggested by the prior art. MPEP 2143.01 (emphasis added). “All words of a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

In rejecting the elements of the independent claims, the examiner has combined the allegedly admitted prior art in view of Goodman and Smith. However, references cannot be combined unless there is some motivation or suggestion in the prior art for the combination. The critical inquiry is whether there is something in the prior art to suggest the combination. In the absence of such a suggestion or motivation, the combination, and any rejection premised on such combination, is improper. In particular, references cannot be combined if their combination would teach away from the claimed invention. Here, the asserted prior art identified by the

examiner cannot properly be combined because the art cited by the examiner, namely Goodman, teaches away from the invention. Moreover, the examiner recognizes that Goodman teaches away from the invention.

1. Goodman

Goodman does not disclose selecting a processor for handling a system management interrupt from a set of capable processors. On the contrary, Goodman assumes that all system management interrupts will be handled by a single, dedicated processor. Goodman carefully and clearly explains that only the “boot processor” (processor 12a of Figure 1 of Goodman) is able to serve as the system management interrupt handler:

Although each of the processors 12 accepts the SMI, only the boot processor (e.g., system processor 12a) executes an SMI handler to service the SMI

(Goodman, column 4, lines 56-58). Goodman does not disclose or even suggest a method for handling system management interrupts in which a selection is made among the multiple processors that are operable to handle the system management interrupt. In Goodman, “only the boot processor” can handle the system management interrupt.

2. Goodman Teaches Away From the Claimed Invention

Goodman does in fact teach away from the claimed invention, as Applicants claim exactly what Goodman discourages. A reference teaches away from the invention when a person of ordinary skill in the art, upon reading the reference, would be led down a path that is divergent from the path of the patent applicant. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353 (Fed. Cir. 1999); *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (explaining that a reference teaches away if it suggests a line of development that is unlikely to produce the result sought by

the applicant). It is improper to combine references that teach away from their combination. *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1983); MPEP 2145.

Here, Goodman is an improper candidate for combination because Goodman teaches away from the claimed invention. Goodman teaches away by expressly providing that all system management interrupts are to be handled by a *single, dedicated* processor. Goodman plainly discloses that “only the boot processor” is to be involved in handling the system management interrupt (column 4, line 57).

There is no teaching from Goodman to suggest that any processor *other than* the boot processor is operable to handle a system management interrupt. A plain reading of Goodman would lead a person of ordinary skill to conclude that only a single, designated processor may be designated as the processor responsible for handling a system management interrupt. Nowhere does Goodman suggest that multiple processors could be used to handle system management interrupts. To the contrary, Goodman states that “only the boot processor” is to be used for that task. Goodman cannot teach or suggest that a processor for handling an issued system management interrupt can be selected from each of the processors of the computer system.

Goodman thus necessarily includes a well-developed teaching (“only the boot processor”) that is directly contrary to the claimed invention, which involves a selection among multiple processors operable to handle a system management interrupt. Goodman itself teaches away from the combination suggested by the examiner. Therefore, Applicants respectfully submit that Goodman is an improper candidate for combination.

3. The Examiner Recognizes That Goodman Teaches Away

The examiner recognizes that Goodman teaches away from the claimed invention. To avoid the portions of Goodman that teach away from the claimed invention, the examiner chose not to consider portions of Goodman. The portions of Goodman that were not considered by the examiner do in fact teach away from the claimed invention. Otherwise, the examiner could have considered the entirety of Goodman, instead of an isolated portion of Goodman. Thus, instead of considering Goodman as a whole, the examiner applies only a single teaching of Goodman, thereby ignoring the portions of Goodman that plainly teach away from the claimed invention.

In rejecting independent claims 1, 16, and 22, the examiner stated that the “103(a) Rejection only applies the teaching of the Goodman’s signature scanning,” as if this teaching can exist in a vacuum. The examiner applied this isolated teaching of Goodman, as opposed to portions of Goodman that do teach away from the claimed invention, because “such teaching of the signature scanning does not teach away from the claimed invention.” The implication of this statement and analysis is clear: Goodman, when properly considered as a whole does in fact teach away from the claimed invention.

In the pending office action, the examiner recognizes that Goodman teaches away from the claimed invention and improperly ignores the teachings of the entirety of Goodman. To support the rejection, the examiner must improperly reach out to the allegedly admitted prior art in combination with an isolated teaching of Goodman because such teaching “does not teach away from the claimed invention.” Thus, the examiner had no choice but to improperly ignore the critical teachings of Goodman that teach away from the combination. Because the rejection

of the pending claims on obviousness grounds on the basis of Goodman is improper, the rejection should be withdrawn.

4. Goodman Must Be Considered in Its Entirety

The examiner, in support of the rejection, points to a single teaching in Goodman. The examiner stated: “The 103(a) Rejection only applies the teaching of the Goodman’s signature scanning.” The examiner asserts only a certain teaching of Goodman because “such teaching of the signature scanning does not teach away from the claimed invention.” However, Applicants respectfully submit that the defects of Goodman cannot be cured by picking and choosing only portions of the reference.

It is well established that each prior art reference must be considered in its entirety, including those portions that point to the nonobviousness of the invention at issue. It is improper to choose language from only a portion of a reference when the entire reference, read as a whole, would suggest to a person of ordinary skill in the art a result far different from the selected excerpt. The totality of a reference’s teachings must be considered. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550-51 (Fed. Cir. 1983); *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986) (stating that the prior art as a whole must be considered); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988) (reinforcing that the entire prior art and prior art patents must each be read as a whole). “[I]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965).

Here, when considering the teachings of Goodman as a whole, a person of ordinary skill would be encouraged to use *only* a single, designated processor as the processor responsible for handling a system management interrupt. When considered as a whole, the prior art counsels directly against applicants' invention. This is "strong evidence" of the nonobviousness of the invention because Goodman teaches a solution that is the opposite of the invention of the present application. "[M]atter in the prior art which counsels against doing what the inventor did is strong evidence that the inventor's solution is not obvious." *Johnson & Son, Inc. v. Gillette Co.*, 1989 WL 87374, *42, Civ. A. Nos. 83-2657-N, 83-3201-N, (D. Mass. 1989). Therefore, Applicants respectfully submit that Goodman must be considered in its entirety, and, when Goodman is considered in its entirety, Goodman teaches away from the claimed invention. As a result, a rejection of the pending claims on the basis of Goodman is improper and should be withdrawn.

B. Dependent Claims 4-8, 19-21, and 23

Dependent claims 4-8, 19-21, and 23 will not be discussed individually herein, as each of these claims depends, either directly or indirectly, from an otherwise allowable base claim.

Conclusion

Applicants respectfully submit that the pending claims 1, 4-8, 16, and 19-23 of the present invention, as previously amended, are allowable. Applicants respectfully request that the rejection of the pending claims be withdrawn and that these claims be passed to issuance.

Respectfully submitted,



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